APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/717,576	11/21/2000	John F. Fairclough	TRO4-BK25	2130

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EXAMINER
WINTER, JOHN M

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/717,576	FAIRCLOUGH ET AL.
	Examiner	Art Unit	
	John M Winter	3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>02 October 2004</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,3-7,12 and 14-22</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,3-7,12 and 14-22</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Status
Claims 1,3-7,12 and 14-22 remain pending

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Response to Arguments

The Applicant's arguments filed on October 2, 2004 have been fully considered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-3, 12-15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Randle et al. (US Patent 5,974,146) and further in view of Simonoff (US Patent 6,611,351).

As per claim 1,
Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network comprising the following steps:
connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
transmitting an order from the client computer to the merchant server; (figure 4)
selecting payment by check; (figure 6)

inputting customer data at the client computer; (column 13, line 64)

transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)

transmitting customer data from the check server to a check verification server; (column 15, line 1-7)

transmitting an approval from the check verification server to the check server (column 15, line 1-7)

Pare Jr. et al. ('148)does not explicitly disclose printing a check Simonoff ('351) discloses printing a check. (Figure 2) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Simonoff ('351) method in order to allow the seller to generate physical proof of the transaction.

Simonoff ('351) discloses the claimed invention except for "(print a check) at a location remote from the client computer". It would have been obvious to one having ordinary skill in the art at the time the invention was made to (print a check) at a location remote from the client computer, since it has been held that re-arranging parts of an invention involves only routine skill in the art . *In re Japikse*, 86 USPQ 70.

Pare Jr. et al. ('148) does not explicitly disclose confirming the order or payment by a message from the merchant server to the client computer and the check verification sender. Randle et al. ('146) discloses confirming the order or payment by a message from the merchant server to the client computer and the check verification sender. (Figure 4, Column 9, lines 1-22) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Randle et al. ('146) method in order to protect the consumer from fraud.

As per claim 3,
Pare Jr. et al. ('148) discloses the method of Claim 1
    where the network is the Internet.(Figure 4)

As per claim 4,
Pare Jr. et al. ('148) discloses the method of Claim 1

Pare Jr. et al. ('148)does not explicitly disclose the check is printed by a secure printer connected to a check printing station at the remote location. Simonoff ('351) discloses the check is printed by a secure printer connected to a check printing station at the remote location (Column 10, lines 8-53; Figure 6) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Simonoff ('351) method in order to allow the seller to generate physical proof of the transaction.

As per claim 12,
        Pare Jr. et al. ('148) discloses a method for settling and verifying checks over a network comprising the following steps:

connecting a client computer to a merchant server at a location remote from
the client computer;(column 14, lines 34-42)

transmitting an order from the client computer to the merchant server; (figure 4)

selecting payment by check; (figure 6)

connecting the client computer to a check server;(column 13, lines 66-67; column 14,
lines 1-19)

inputting customer data at the client computer; (column 13, line 64)

transmitting customer data from the client computer to the check server; (column 13, line
66-67; column 14, lines 1-2)

transmitting customer data from the check server to a check verification
server; (column 15, line 1-7)

transmitting an approval from the check verification server to the check
server (column 15, line 1-7)

settling a check by an ACH settlement system.(Figure 7).

Pare Jr. et al. ('148) does not explicitly disclose confirming the order or payment by a
message from the merchant server to the client computer and the check verification sender.
Randle et al. ('146) discloses confirming the order or payment by a message from the
merchant server to the client computer and the check verification sender. (Figure 4, Column
9, lines 1-22) It would be obvious to one having ordinary skill in the art at the time the
invention was made to combine the Pare Jr. et al. ('148) method with the Randle et al. ('146)
method in order to protect the consumer from fraud.

Pare Jr. et al. ('148)does not explicitly disclose printing a check
Simonoff ('351) discloses printing a check. (Figure 2) It would be obvious to one having
ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al.
('148) method with the Simonoff ('351) method in order to allow the seller to generate
physical proof of the transaction.

Simonoff ('351) discloses the claimed invention except for "(print a check) at a location
remote from the client computer". It would have been obvious to one having ordinary skill
in the art at the time the invention was made to (print a check) at a location remote from the
client computer, since it has been held that re-arranging parts of an invention involves only
routine skill in the art . *In re Japikse*, 86 USPQ 70.

As per claim 14
Pare Jr. et al. ('148) discloses the method of Claim 12
Pare Jr. et al. ('148) does not explicitly disclose the network is the ACH network. Hills et
al. ('528) discloses the network is the ACH network. (Abstract) It would be obvious to one
having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et
al. ('148) method with the Hills et al. ('528) method in order to utilize a well known and
commercially viable system for check clearing.

As per claim 15
Pare Jr. et al. ('148) discloses the method of Claim 12
Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check
verification server in a merchant file in the check server; downloading the merchant file from

the check server to the ACH settlement system. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server;(Abstract) downloading the merchant file from the check server to the ACH settlement system (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

As per claim 21,
Pare Jr. et al. ('148) discloses the method of claim 1 further compromising: presenting the printed check for payment. (Figure 7)

As per claim 22,
Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network comprising the following steps:
connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
transmitting an order from the client computer to the merchant server; (figure 4)
selecting payment by check; (figure 6)
connecting the client computer to a check server;(column 13, lines 66-67; column 14, lines 1-19)
inputting customer data at the client computer; (column 13, line 64)
transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)
transmitting customer data from the check server to a check verification server; (column 15, line 1-7)
transmitting an approval from the check verification server to the check server (column 15, line 1-7)
Official Notice is taken that "the approval comprises a guarantee of payment to a merchant" is common and well known in prior art in reference to commerce. It would have been obvious to one having ordinary skill in the art at the time the invention was made to guarantee the transaction in order to promote commerce.
Pare Jr. et al. ('148)does not explicitly disclose the check is printed by a secure printer connected to a check printing station at the remote location. Simonoff ('351) discloses the check is printed by a secure printer connected to a check printing station at the remote location (Column 10, lines 8-53; Figure 6) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Simonoff ('351) method in order to allow the seller to generate physical proof of the transaction.

Claim 5,7-11, and 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pare,
Jr. et al. (US Patent No 6,230,148) in view of Carlson et al. (US Patent No 5,053,607) and
further in view of Hills et al. (US Patent No 6,164,528)

As per claim 5,
Pare Jr. et al. ('148) discloses the method of Claim 1
Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check
verification server in a merchant file in the check server; downloading the merchant file from
the check server to a check printing station. Hills et al. ('528) discloses storing the approval
from the check verification server in a merchant file in the check server;(Abstract)
downloading the merchant file from the check server to a check printing station (Column 12,
lines 54-67) It would be obvious to one having ordinary skill in the art at the time the
invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528)
method in order to protect the merchant from fraud caused by a customer with insufficient
funds to cover the check.

As per claim 7,
Pare Jr. et al. ('148) discloses the method of Claim 6
Pare Jr. et al. ('148) does not explicitly disclose the secure printer is a magnetic ink
character recognition-enabled printer. Simonoff ('351) discloses the secure printer is a magnetic
ink character recognition-enabled printer. (column 10, lines 54-57) It would be obvious to one
having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al.
('148) method with the Simonoff ('351) method in order to generate a paper check that is
routable via standard bank routing procedures.

As per claim 9,
Pare Jr. et al. ('148) discloses the method of Claim 6
where the network is the Internet.(Figure 4)

As per claim 10,
Pare Jr. et al. ('148) discloses the method of Claim 6
where the approval comprises the customer data transmitted from the client computer to
the check server. (column 15, line 1-7)

As per claim 16
Pare Jr. et al. ('148) discloses a system for settling and verifying checks over a network
comprising
        a client computer connected via a network to a merchant server; (column 14, lines 34-42)
        the merchant server is connected to a check printing station, a printer and a check server
via a network; where by the client computer transmits an order to a merchant
server at a location remote from the client computer (figure 6)
        the client computer selects payment by check; (figure 6)

the client computer is connected to a check server; (column 13, lines 66-67; column 14, lines 1-19)

customer data is input to the client computer and transmitted to the check server (column 13, line 64)

the customer data is transmitted from the check server to a check verification server; (column 15, line 1-7)

an approval is transmitted from the check verification server to the client computer and the check server; (column 15, line 1-7)

Pare Jr. et al. ('148) does not explicitly disclose the approval is stored in a merchant file in the check server; the merchantfile is downloaded from the check server to the check printing station. Hills et al. ('528) discloses the approval is stored in a merchant file in the check server; (Abstract) the merchantfile is downloaded from the check server to the check printing station; (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.

Pare Jr. et al. ('148)does not explicitly disclose a check is printed by the printer Carlson et al. ('607) discloses a check is printed by the printer.(Figure 6) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Carlson et al. ('607) method in order to allow the seller to generate physical proof of the transaction.

Pare Jr. et al. ('148) does not explicitly disclose confirming the order or payment by a message from the merchant server to the client computer and the check verification sender. Randle et al. ('146) discloses confirming the order or payment by a message from the merchant server to the client computer and the check verification sender. (Figure 4, Column 9, lines 1-22) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Randle et al. ('146) method in order to protect the consumer from fraud.

As per claim 17
Pare Jr. et al. ('148) discloses the method of Claim 16
Pare Jr. et al. ('148) does not explicitly disclose the network is the ACH network. Hills et al. ('528) discloses the network is the ACH network. (Abstract) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to utilize a well known and commercially viable system for check clearing.

As per claim 19,
Pare Jr. et al. ('148) discloses the method of Claim 16
Pare Jr. et al. ('148) does not explicitly disclose the printer is a magnetic ink character recognition-enabled printer. Carlson et al. ('607) discloses the printer is a magnetic ink character recognition-enabled printer. (column 10, lines 54-57) It would be obvious to one

('148) method with the Carlson et al. ('607) method in order to generate a paper check that is routable via standard bank routing procedures

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pare, Jr. et al. (US Patent No 6,230,148) in view of Hills et al. (US Patent No 6,164,528) and further in view of Randle et al. (US Patent 5,974,146) and further in view of Simonoff (US Patent 6,611,351).

As per claim 6,
Pare Jr. et al. ('148) discloses a method for printing and verifying checks over a network comprising the following steps:
connecting a client computer to a merchant server at a location remote from the client computer;(column 14, lines 34-42)
transmitting an order from the client computer to the merchant server; (figure 4)
selecting payment by check; (figure 6)
connecting the client computer to a check server;(column 13, lines 66-67; column 14, lines 1-19)
inputting customer data at the client computer; (column 13, line 64)
transmitting customer data from the client computer to the check server; (column 13, line 66-67; column 14, lines 1-2)
transmitting customer data from the check server to a check verification server; (column 15, line 1-7)
transmitting an approval from the check verification server to the check server (column 15, line 1-7)
Pare Jr. et al. ('148) does not explicitly disclose storing the approval from the check verification server in a merchant file in the check server; downloading the merchant file from the check server to a check printing station. Hills et al. ('528) discloses storing the approval from the check verification server in a merchant file in the check server;(Abstract) downloading the merchant file from the check server to a check printing station (Column 12, lines 54-67) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Hills et al. ('528) method in order to protect the merchant from fraud caused by a customer with insufficient funds to cover the check.
Pare Jr. et al. ('148)does not explicitly disclose printing a check with a secure printer connected to the check printing station at the location remote from the client computer. Simonoff ('351) discloses printing a check with a secure printer connected to the check printing station at the location remote from the client computer. (Figure 2) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Simonoff ('351) method in order to allow the seller to generate physical proof of the transaction.
Pare Jr. et al. ('148) does not explicitly disclose confirming the order or payment by a message from the merchant server to the client computer and the check verification sender. Randle et al. ('146) discloses confirming the order or payment by a message from the merchant server to the client computer and the check verification sender. (Figure 4, Column

9, lines 1-22) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Pare Jr. et al. ('148) method with the Randle et al. ('146) method in order to protect the consumer from fraud.
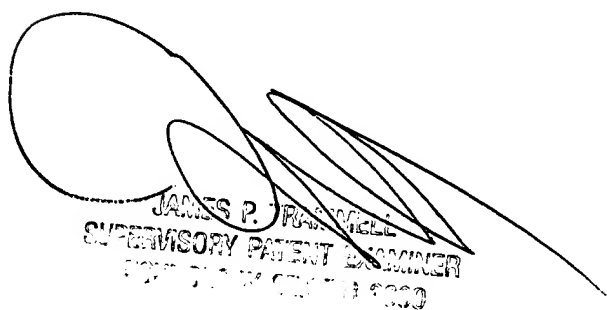
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M Winter whose telephone number is (703) 305-3971. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on (703)305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

JMW
December 13, 2004